

### **REMARKS**

In view of the following remarks, the Examiner is requested to allow claims 1-13, 17-19, 34, 49, 50, 56, 57, 59-70, the only claims pending and under examination in this application.

The Examiner is thanked for acknowledging that Claims 17-19 contain allowable subject matter.

### ***Formal Matters***

Independent Claim 1 has been amended to include the limiting step. Claim 59 has been amended to specify that access to feature locations outside a sub-array is limited. Support for these amendments is found throughout the specification, for example, on page 3, lines 20-25.

Claims 5, 13, 64 and 65 have been amended for proper antecedent basis in light of the amendment to Claims 1 and 59.

Claim 59 has been further amended to include the step of acquiring and saving signal data from the sub-array using the retrieved sub-array pattern. Support for this amendment may be found on page 23, lines 20-22 of the specification and in originally filed Claim 6.

As no new matter has been introduced by way of these amendments, entry thereof by the Examiner is respectfully requested.

### ***Claim Rejections - 35 U.S.C. § 101***

Claims 59-63 and 65 are rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Specifically, the Examiner alleges that the final step of retrieving a sub-array pattern does not indicate that the result is communicated to the outside world or rendered in a tangible form. Office Action, the sentence bridging pages 3-4.

Without conceding as to the correctness of this rejection, and solely in the interest of expediting prosecution, Claim 59 has been amended to include the step of “acquiring and saving signal data from said sub-array using said retrieved sub-array pattern”. As such, Claim 59 produces a useful, concrete and tangible result, i.e., acquiring and saving of signal data from a sub-array of a chemical array. Applicants submit that acquiring and saving signal data is clearly a practical application producing a real-world result. As Claims 60-63 and 65 depend from Claim 59, they likewise are directed to statutory subject matter.

Applicants submit that the rejection under 35 U.S.C. §101 has been adequately addressed. The Examiner is thus respectfully requested to withdraw the rejection.

***Claim Rejections - 35 U.S.C. § 102***

Claims 1-13, 49, 50, 56, 57, 59-63, 65, and 68 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Kaushikkar (US 2002/0024026 A1). Applicants respectfully traverse this rejection as applied to the amended claims.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, (Fed. Cir. 1987).

The standard for anticipation under section 102 is one of strict identity. An anticipation rejection requires a showing that each limitation of a claim be found in a single reference, *Atlas Powder Co. v. E.I. DuPont de Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984). Further, an anticipatory reference must be enabling, see *Akzo N.V. v. United States Int'l Trade Comm'n* 808 F.2d 1471, 1479, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986), *cert denied*, 482 U.S. 909 (1987), so as to place one of ordinary skill in possession of the claimed invention. To anticipate a claim, a prior art reference must disclose every feature of the claimed invention, either explicitly or inherently. *Glaxo v. Novopharm, Ltd.* 334 U.S. P.Q.2d 1565 (Fed. Cir. 1995).

Claims 1 and 59 are the only independent claims currently under examination in the subject application. Claim 1 includes the elements of a "test request" that "references a type of test to be performed" and "limiting access to feature locations outside any retrieved sub-array pattern". Claim 59 includes the elements of a "test request" that "references a type of test to be performed" and "acquiring and saving signal data from said sub-array using said retrieved sub-array pattern, wherein access to feature locations outside any retrieved sub-array pattern is limited".

Applicants submit that Kaushikkar fails to teach both the test request element and limiting access element of Claims 1 and 59.

First, Applicants submit that Kaushikkar is completely silent on limiting access to any feature locations on a chemical array, including those that reside outside of a retrieved sub-array pattern. Accordingly, Kaushikkar does not teach this element of the claimed invention. This rejection may be withdrawn for this reason alone.

Additionally, Applicants maintain their position that Kaushikkar fails to teach retrieving a sub-array pattern using a test request which references a "type of test to be performed" because the "test request" of Kaushikkar is specifically based on location data of the features of the array (i.e., providing information about the location of a subset of features on an array for sample contacting and scanning).

Kaushikkar's method is providing users with array content files containing information regarding probe feature locations, and allows the users to select an array content file based on the probe feature locations. The "array content file" (e.g., a csv file) stores probe location information. As described in ¶ 0089, a user may select an array content file by browsing available specific csv files containing probe location information. FIG. 9 illustrates file identifiers (GUI 782A) described in Kaushikkar as a second way to specify probe feature locations. The browsing can be carried out in a file

tree format, as illustrated in FIG. 9, an expandable-collapsible csv node format, or a pull down list using graphical elements. Kaushikkar's ¶ 0089 also describes step 1110 as specifying probe feature location, step 1120 as producing an array content file, and 1130 as receiving user selections of file identifiers in FIG. 11. As such, Kaushikkar's method employs probe feature locations to retrieve a sub-array, which does not reference a type of test to be performed.

Accordingly, Kaushikkar fails to teach a test request that "references a type of test to be performed" as claimed.

Because Kaushikkar fails to teach each and every element of the claimed invention, this reference cannot anticipate it. Applicants thus respectfully request that this rejection be withdrawn.

#### ***Claim Rejections - 35 U.S.C. § 103***

Claims 69 and 70 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kaushikkar. The Applicants respectfully traverse this rejection as applied to the amended claims.

In making this rejection, the Examiner asserts that Kaushikkar's system specifying scanning array area based on feature location data renders the claims obvious. Despite that Kaushikkar does not teach sub-array patterns that overlap or do not overlap, the Examiner asserts that one of ordinary skill in the art may specify any subset in an array such that the subsets may or may not overlap.

In order to meet its burden in establishing a rejection under 35 U.S.C. §103, the Office must first demonstrate that a prior art reference, or references when combined, teach or suggest all claim elements. *See, e.g., KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007); *Pharmastem Therapeutics v. Viacell et al.*, 491 F.3d 1342, 1360 (Fed. Cir. 2007); MPEP § 2143(A)(1). In addition to demonstrating that all elements

were known in the prior art, the Office must also articulate a reason for combining the elements. See, *e.g.*, *KSR* at 1741; *Omegaflex, Inc. v. Parker-Hannifin Corp.*, 243 Fed. Appx. 592, 595-596 (Fed. Cir. 2007) citing *KSR*. Further, the Supreme Court in *KSR* also stated that that “a court *must* ask whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR* at 1740; emphasis added. As such, in addition to showing that all elements of a claim were known in the prior art and that one of skill had a reason to combine them, the Office must also provide evidence that the combination would be a predicted success.

Applicants submit that Kaushikkar fails to teach or suggest each and every element of the rejected claims.

As detailed above, Applicants contend that Kaushikkar fails to teach both the test request element and limiting access element of Claims 1 and 59.

Applicants further contend that Kaushikkar also fails to even suggest these elements. First, as Kaushikkar is completely silent on limiting access to feature locations outside any retrieved sub-array pattern, this reference simply cannot suggest this claim element. In other words, in the absence of any teaching with regard to limiting access to feature locations on a chemical array, Kaushikkar fails to suggest such an element.

Kaushikkar also fails to suggest retrieving a sub-array using a test request which “references a type of test to be performed” because (as detailed above and in previous responses) this reference employs location data for identifying sub-arrays of a chemical array and not a type of test to be performed.

Accordingly, Applicants submit that Kaushikkar fails to teach or suggest each and every element of the claims as required to establish a *prima facie* case of obviousness. Applicants thus respectfully request that this rejection be withdrawn.

### **CONCLUSION**

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone John Brady at (408) 553-3584.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10021296-1.

Respectfully submitted,

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